

REMARKS/ARGUMENTS

The amendment is in response to the Final rejection dated March 16, 2009. Claims 1-65 and 67-96 have been canceled without prejudice, disclaimer and/or in view of the rejections. Claims 66 and 97-103 are pending in this application.

Claim Rejections - 35 USC § 103

On page 2 of the action, Claims 66, 70, and 97-103 are rejected as understood under 35 U.S.C. 103(a) as being unpatentable over Contreras (4,015,630) in view of Schuler (5,685,297) and in further view of Dey (3,426,790) and further in view of Hershman (2,725,072). Applicant respectfully traverses this rejection.

Independent claims 66 and 102 recites in part:

a filter located within the passageway so that fluid must pass through the filter to pass through the exit opening; and
a retainer device for removably securing the filter within the exit opening of the passageway.

The action indicates that "Contreras fails to disclose a filter located within the passageway so that fluid must pass through the filter to pass through the exit opening, a retainer for removably securing the filter within the exit opening of the passageway." However, the action indicates that "Schuler discloses ... a filter (20) located within the passageway so that fluid must pass through the filter to pass through the exit opening." The action however further indicates that "Schuler fails to disclose that a retainer for removably securing the filter within the exit opening of the passageway is used." The action thus uses Dey indicating that "Dey discloses a retainer (32) for removably securing the filter within the exit opening of the passageway (col. 2, lines 56-60)."

Schuler, in col. 3, lines 42 - 50, does describes "a freeze resistant first stage pressure regulator 10 in accordance with the present invention having a housing 12 with

a yoke 14 which provides a means for attaching the housing 12 to a high pressure source of breathable gas (not shown), a filter 20 prevents contamination from entering the housing 12 from the high pressure source of breathable gas which is introduced to a seat 22.” However, the filter is not at the exit opening but rather at an inlet opening (near seat 22).

Dey describes in col. 2, lines 56-60, that valve “body 12 is further provided with a fluid passageway 12a as shown most clearly in FIGURE 3 of the drawings. The inlet 12b to such passageway 12a is provided with a filter 30 which is held in place by a resilient washer 32 and an O-ring 34.” However, like Schuler, Dey describes the filter at an inlet opening (the inlet 12b provided with the filter 30) and thus not at the exit opening. Furthermore, since Dey describes a filter at an inlet, Dey also does not describe a retainer device for removably securing the filter within the exit opening of the passageway.

In assessing the differences between the claim and the cited references, every feature of the claim must be disclosed or suggested in the cited references or known to one skilled in the art in making a *prima facie* case of obviousness. A *prima facie* case of obviousness also requires a reasonable expectation of success in the modification or combination of references, which must be found in the cited references or must be known to one skilled in the art *In re Vaeck*, 947 F2d 488, 20 USPQ2d 1438 (Fed Cir. 1991). As the cited references alone or when combined do not teach or suggest all the claim limitations, a *prima facie* case of obviousness is not established.

Additionally, Schuler and Dey each provide their own solution of a filter being in the inlet opening and thus one skilled in the art would not be motivated to modify the teachings of Schuler or Dey to have the filter within the exit opening to arrive at the claimed invention unless hindsight reasoning is used. Furthermore, the filter of the

current application is secured within the exit opening by the retainer device which neither Schuler and/or Dey provide.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (See MPEP 2142). Thus, when taking the invention as provided in claims 66 and 102, as a whole, one skilled in the art would not arrive at the claimed invention by modifying and would not be motivated to modify the teachings of Contreras, Schuler, Dey and Hershman to arrive at the claimed invention unless hindsight reasoning is used.

Independent claim 66 also recites in part:

wherein the moveable cover member is adapted to move from the first position to the second position when the valve is attached to a source of compressed gas; and

wherein the moveable cover member is adapted to automatically move from the second position to the first position when the valve is disconnected from a source of compressed gas.

Hershman however describes a coupling element 20 with covers 38 biases closed when a fluid pressure operated instrument is removed. However, the coupling element 20 always remains connected to a source of fluid pressure such as a pump (not shown) carried by the tractor. (See col. 2, lines 39-45).

In contrast, Claim 66 provides that limitations of "when the valve is attached to a source of compressed gas" and "when the valve is disconnected from a source of compressed gas". These limitations are not described or suggested by Hershman.

As such, Hershman does not describe a moveable cover member adapted to automatically move from the second position to the first position when the valve is disconnected from a source of compressed gas as provided in claim 66, as the source of fluid pressure of Hershman always remains connected. Additionally, Contreras, Schuler and Dey each provide their own solution of a closing device but none provide the suggestion of a moveable cover member adapted to automatically move from the second position to the first position when the valve is disconnected from a source of compressed gas. Thus, when taking the invention as provided in claim 66, as a whole, one skilled in the art would not arrive at the claimed invention by modifying and would not be motivated to modify the teachings of Contreras, Schuler, Dey with Hershman to arrive at the claimed invention unless hindsight reasoning is used.

Therefore, for at least the above-noted reasons, claims 66 and 102 are not obvious in view of Contreras, Schuler, Dey and Hershman. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claim 70 has been canceled without prejudice, disclaimer and/or in view of the rejection.

Claims 97-101 and 103

Claims 97-101 and 103 depend from independent claim 66. Since claims 97-101 and 103 depend from independent claim 66 and thus incorporate the features recited in corresponding claim and contain additional limitations that, when considered as a whole are patentably distinguishable over the references of record, claims 97-101 and 103 are believed to be patentable. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Also, regarding claim 97, the action on page 4 indicates that Hershman utilizes a biasing element (41) which is offset from the inlet as seen in Figure 1 and therefore is not aligned with the inlet opening. However, claim 97 also in part provides that a biasing element ... **is attached to the housing**. The action and the cited references are silent as to this feature. As the cited references alone or when combined do not teach or suggest all the claim limitations, a prima facie case of obviousness is not established. Accordingly, for at least this reason, reconsideration and withdrawal of the rejection are respectfully requested.

Regarding claims 99 and 100, the action on page 4 indicates that the biasing element comprises a spring hinge and a resilient arm as seen in Figure 2.

However, claim 99 recites that the biasing element comprises a spring hinge attached to an arm coupling the movable cover member to an **attachment member**. The action and the cited references are silent as to an attachment member. As the cited references alone or when combined do not teach or suggest all the claim limitations, a prima facie case of obviousness is not established. Accordingly, for at least this reason, reconsideration and withdrawal of the rejection are respectfully requested.

Regarding claim 100, **claim 100** recites that the biasing element comprises a resilient arm attached to the movable cover member and the biasing element does not include a spring. The action and the cited references are silent as to a biasing element that does not include a spring. In fact, the action and Hershman also provides that a biasing element that includes a spring. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Therefore, the action and Hershman teach and suggest limitations that lead away from the invention as provided by claim 100.

Also, as the cited references alone or when combined do not teach or suggest all the claim limitations, a prima facie case of obviousness is not established. Accordingly, for at least this reason, reconsideration and withdrawal of the rejection of claims 97-101 and 103 are respectfully requested.

Independent Claim 102 (continued)

In addition to the limitations previously described, **independent claim 102** also recites that:

the screw member is distal from the moveable cover member with
the moveable cover member being in and biased into the first position.

The action on page 2 indicates that Contreras describes that a "moveable cover member being biased towards the first position (12 and 13 screws the cover into place therefore it is biased into the first position)." Claim 102 however provides that the screw member is distal from the moveable cover member with the moveable cover member being in and biased into the first position which is not taught or suggested by Contreras.

Additionally, Contreras describes a cap 12a loosely mounted on the yoke (see col. 2, lines 4-21). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Thus, based on the statement on page 2 of the action, Contreras appears to teach and suggest limitations that lead away from the invention as provided by claim 102.

Also, contrary to the statement on page 2, the action on page 5 indicates that regarding claims 102 and 103, the valve further comprising a screw member (15) threadably connected to the housing and attached to a hand knob (12), the screw member being distal from the moveable cover member with the moveable cover member being in and biased into the first position.

Thus, if Contreras describes a screw member biasing the cover member towards the first position (12 and 13 screws the cover into place therefore it is biased into the first position), then how does Contreras describe the moveable cover member being in and biased into the first position when the screw member is distal from the movable cover member. Also, with Contreras describing the cover being loosely mounted and thus not biased closed when the screw member is distal from the cover, why would one skilled in the art be motivated to have a closing device that is biased closed when the screw member is distal from the cover (i.e., modify Contreras with Hershman).

The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Therefore, without a clear articulation of the reasons why the invention as provided by claim 102 would have been obvious, the rejection cannot be supported. Furthermore, the cited references or the combination thereof do not teach or suggest the claimed

invention and one skilled in the art would not modify or be motivated to modify the cited references to arrive at the claimed invention. For at least these reasons, claim 102 is not obvious over the cited references. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance or in better condition for appeal. Reconsideration of the application and allowance of the claims are respectfully requested. Also, although the present paper may include a combination of alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding that previously pending claims in this application are not patentable over the cited references. Rather, any alterations and/or characterizations are made to strictly facilitate prosecution of this application. As such, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.


Appln No. 10/614,395

Reply to Office action of March 16, 2009

Applicants have submitted amendments and arguments believed to be sufficient to overcome all of the outstanding rejections. Consequently, Applicants have not advanced every argument for the allowability of the claims over the references of record. As such, Applicants do not acquiesce to any of the Examiner's statements or characterizations not specifically traversed. If the Examiner should have any remaining questions or objections, a telephone interview to discuss and resolve these issues is respectfully requested.

Respectfully submitted,

KAUTH, POMEROY, PECK & BAILEY LLP

By 

Patrick Y. Ikehara

Registration No. 42,681

949.852.0000

PYI
7878